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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,260	06/15/2004	Paul Beardow	22557-3013/US	9345

34205 7590 02/13/2007
OPPENHEIMER WOLFF & DONNELLY LLP
45 SOUTH SEVENTH STREET, SUITE 3300
MINNEAPOLIS, MN 55402

EXAMINER

AMIN, JWALANT B

ART UNIT	PAPER NUMBER
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2628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/500,260	Applicant(s) BEARDOW, PAUL	
	Examiner Jwalant Amin	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 139-191 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 139-191 is/are rejected.
- 7) ☒ Claim(s) 148, 153, 155 and 156 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/15/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 6/15/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, and unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

2. Claim 148 is objected to because of the following informalities: the phrase "the image" appearing on lines 1-2 is repeated. Appropriate correction is required.
3. Claims 153, 155 and 156 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 144, 146 and 147 respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 139, 149, 157, 166, 175 and 184 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over each of the claims 1, 2, 3, 4, 6, 7 and 15 of U.S. Patent No. 5,600,767.

1. Specifically, it is well established that "Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before" In re KARLSON (CCPA) 136 USPQ 184 (1963). The above claims in the current application, that is to say all of them, are **broader** in all respects than the reference.

2. To perform analysis required, claim 166 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 166: Current Application	Claim 1: Patent No. 5,600,767
An apparatus for generating an image for display	An image creation device for forming a desired image

Means for selecting a set of part images from among a plurality of part images	Selection means for selecting part images from among the plurality of part images stored in said [part image storage means]
Means for specifying properties for each part image in said set of part images	Attribute setting means for setting an attribute of the desired image to be formed
Means for specifying a position, to be occupied in the display, for each part image in said set of part images, and means for displaying each part image according to the specifications	Synthesis means for placing at least one of the part images selected by said selection means at a specified position in accordance with the attribute set by said attribute setting means, and output means for outputting the desired image formed by said synthesis means

As per Karlson, the above-cited claim is identical except for the omission of the elements above. It would have been obvious to one of ordinary skill in the art at the time of present invention to remove the limitations of "part image storage means" above without changing the scope of claim 1 because the added limitation as recited in Patent No. 5,600,767 is an additional feature to claim 166, and thus it is not necessary generate an image for display.

Therefore, this claim is properly subject to ODP rejection.

3. To perform analysis required, claim 139 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 139: Current Application	Claim 1: Patent No. 5,600,767
A method for generating an image for display	An image creation device for forming a desired image

Claim 139 in the current application is a method for generating an image for display and claim 1 of Patent No. 5,600,767 is an image creation device for forming a desired image. Therefore, it would have been obvious to one of ordinary skill in the art at the time of present invention to use the method claim 139 of the current application to form the desired image using the image creation device of claim 1 of Patent No. 5,600,767. Please refer to the ODP rejection analysis of claim 166 of current application and claim 1 of Patent No. 5,600,767 for further arguments.

Therefore, this claim is properly subject to ODP rejection.

4. To perform analysis required, claim 175 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 175: Current Application	Claim 1: Patent No. 5,600,767
An apparatus for transmitting an image for display	An image creation device for forming a desired image
Means for sending a signal to specify a set	Selection means for selecting part images

<p>of part images from among a plurality of part images</p> <p>Means for sending a signal to specify properties for each part image in said set of part images</p> <p>Means for sending a signal to specify a position, to be occupied in the display, for each part image in said set of part images</p>	<p>desired image</p> <p>Selection means for selecting part images from among the plurality of part images stored in said [part image storage means]</p> <p>Attribute setting means for setting an attribute of the desired image to be formed</p> <p>Synthesis means for placing at least one of the part images selected by said selection means at a specified position in accordance with the attribute set by said attribute setting means, and output means for outputting the desired image formed by said synthesis means</p> <p>(Note: selection, setting and placing the part image at a specified position involves sending and receiving of a signal, since an input signal is required to select, set or</p>
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	specify the position, and the receiving means receives this input signal to perform these functions)
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As per Karlson, the above-cited claim is identical except for the omission of the elements above. It would have been obvious to one of ordinary skill in the art at the time of present invention to remove the limitations of "part image storage means" above without changing the scope of claim 1 because the added limitation as recited in Patent No. 5,600,767 is an additional feature to claim 175, and thus it is not necessary generate an image for display.

Therefore, this claim is properly subject to ODP rejection.

Therefore, this claim is properly subject to ODP rejection.

5. To perform analysis required, claim 149 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 149: Current Application	Claim 1: Patent No. 5,600,767
A method for transmitting an image for display	An image creation device for forming a desired image

Claim 149 in the current application is a method for transmitting an image for display and claim 1 of Patent No. 5,600,767 is an image creation device for forming a desired image. Therefore, it would have been obvious to one of ordinary skill in the art at the time of present invention to use the method claim 149 of the current application to

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transmit the desired image created using the image creation device of claim 1 of Patent No. 5,600,767. Please refer to the ODP rejection analysis of claim 175 of current application and claim 1 of Patent No. 5,600,767 for further arguments.

Therefore, this claim is properly subject to ODP rejection.

6. To perform analysis required, claim 184 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 184: Current Application	Claim 1: Patent No. 5,600,767
An apparatus for receiving and creating an image for display	An image creation device for forming a desired image
Means for receiving a signal to specify a set of part images from among a plurality of part images	Selection means for selecting part images from among the plurality of part images stored in said [part image storage means]
Means for receiving a signal to specify properties for each part image in said set of part images	Attribute setting means for setting an attribute of the desired image to be formed
Means for sending a signal to specify a position, to be occupied in the display, for each part image in said set of part images,	Synthesis means for placing at least one of the part images selected by said selection means at a specified position in

and means, responsive to said signals, for generating and displaying a specified image	accordance with the attribute set by said attribute setting means, and output means for outputting the desired image formed by said synthesis means (Note: selection, setting and placing the part image at a specified position involves sending and receiving of a signal, since an input signal is required to select, set or specify the position, and the receiving means receives this input signal to perform these functions)
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As per Karlson, the above-cited claim is identical except for the omission of the elements above. It would have been obvious to one of ordinary skill in the art at the time of present invention to remove the limitations of "part image storage means" above without changing the scope of claim 1 because the added limitation as recited in Patent No. 5,600,767 is an additional feature to claim 184, and thus it is not necessary generate an image for display.

Therefore, this claim is properly subject to ODP rejection.

7. To perform analysis required, claim 157 of the current application is compared to claim 1 of Patent No. 5,600,767.

Claim 157: Current Application	Claim 1: Patent No. 5,600,767
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A method for receiving and generating an image for display	An image creation device for forming a desired image
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Claim 157 in the current application is a method for transmitting an image for display and claim 1 of Patent No. 5,600,767 is an image creation device for forming a desired image. Therefore, it would have been obvious to one of ordinary skill in the art at the time of present invention to use the method claim 157 of the current application to transmit the desired image created using the image creation device of claim 1 of Patent No. 5,600,767. Please refer to the ODP rejection analysis of claim 184 of current application and claim 1 of Patent No. 5,600,767 for further arguments.

Therefore, this claim is properly subject to ODP rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 139, 140, 141/139, 141/140, 142, 143/139, 143/140, 147/139, 147/140, 148, 149, 150, 151/149, 151/150, 152, 155/139, 155/140, 156, 157, 158, 159/157, 159/158, 160, 163/157, 163/158, 164, 165/157, 165/158, 166, 167, 168/166, 168/167, 169, 172/166, 172/167, 173, 174/166, 174/167, 175, 176, 177/175, 177/176, 178, 181/175, 181/176, 182, 183/175, 183/176, 184, 185, 186/184, 186/185, 187, 190/184,

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190/185 and 191 are rejected under 35 U.S.C. 102(b) as being anticipated by Kakiyama et al. (US 5,600,767; hereinafter referred to as Kakiyama).

8. Regarding claims 139, 149, 157, 166, 175 and 184 Kakiyama teaches a method and an apparatus (fig. 1, image creation device) for transmitting, receiving and generating an image (fig. 2, fig. 25, col. 2 lines 8-55; the user operates input unit 2 comprising the rightward and leftward arrow and the enter key to select an appropriate part image to be used in the portrait creation process, then the internal unit 4 receives and generates the image and displays on the display unit 3); said method comprising the steps of selecting a set of part images from among a plurality of part images (col. 1 lines 56-58, col. 7 lines 5-12); specifying a position, to be occupied in the display, for each part image in said set of part images (fig. 5, fig. 6, col. 1 lines 61-67, col. 5 lines 35-50); specifying properties for each part image in said set of images (fig. 3, fig. 7, col. 1 lines 59-60, col. 9 lines 4-7 and lines 39-67, col. 10 lines 1-13; depending on the attribute selected by the user, a part image changes its property like location, size, texture, viewpoint, etc.); and displaying each part image according to specifications (col. 1 lines 61-67, col. 10 lines 12-13).

9. Regarding claims 140, 150, 158, 167, 176 and 185 Kakiyama teaches the step of specifying properties of each part of image in said set of part images comprises the step of specifying at least one of a viewpoint (fig. 13; eye image is disposed below the reference synthesis position); texture (fig. 20, col. 12 lines 40-42; eyebrows part image); size (figs. 19A-C, fig. 20; eyes part image).

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10. Regarding claims 141/139, 141/140, 151/149, 151/150, 159/157, 159/158, 168/166, 168/167, 177/175, 177/176, 186/184 and 186/185 Kakiyama teaches the step of providing, in the form of a text message (figs. 19A-C provides a series of text messages for selecting the desired properties of each part image), at least one of the specification of the properties for each part in said set of part images (figs. 19A-C, col. 11 lines 4-24).

11. Regarding claims 142, 160, 169, 178 and 187 Kakiyama teaches the step of compacting codes (image numbers for various parts) used to represent the selections (fig. 3, col. 4 lines 14-25; number indicative of selective part image corresponds to compacting codes used to represent selections).

12. Regarding claims 143/139, 143/140, 152, 165/157, 165/158, 174/166, 174/167, 183/175 and 183/176 Kakiyama teaches the step of receiving the specifications as an appendage to a text message (figs. 19A-C, col. 11 lines 4-24; the contoured selected in fig. 19 A is appended to the text message for selection of hair style in fig. 19 B; both these selections are appended to the text message as shown in fig. 19 C for selecting eyes, and therefore after all the part images are selected an overall text message combining appended selections is created).

13. Regarding claims 147/139, 147/140, 148, 155/139, 155/140, 156, 163/157, 163/158, 164, 172/166, 172/167, 173, 181/175, 181/176, 182, 190/184, 190/185 and 191 Kakiyama teaches the step of displaying the image on at least one of a computer (personal computer/electronic notebooks), a personal digital assistant, and a mobile telephone (col. 20 lines 6-11).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 144/139, 144/140, 145, 146, 153/139, 153/140, 154, 161/157, 161/158, 162, 170/166, 170/167, 171, 179/1751 179/176, 180, 188/184, 188/185 and 189 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakiyama, and further in view of Haataja (US 6,137,836).

16. Regarding claims 144/139, 144/140, 145, 146, 153/139, 153/140, 154, 161/157, 161/158, 162, 170/166, 170/167, 171, 179/1751 179/176, 180, 188/184, 188/185 and 189, although Kakiyama discloses all of the claimed limitations as stated above, Kakiyama does not explicitly teach the step of obtaining said set of part images from a server in a network. However, Haataja teaches a remote station (network) with a computer (server) that transmits composite image of a plurality of primitive pictures (set of part images) to a portable communicator (cellular telephone) (fig. 3, figs. 8-10, col. 6 lines 30-67, col. 7 lines 20-26, col. 8 lines 6-42; the remote station transmitting telephony signals for a cellular telephone corresponds to a mobile telephone network). Therefore, it would have been obvious to one of ordinary skill in the art at the time of present invention to obtain primitive images from a server in a network as demonstrated by Haataja and use it into the method and apparatus of Kakiyama because obtaining

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the pictorial data of an image as a set of simplified composite part images of different primitive pictures reduces the required transmission bandwidths and is transmitted rapidly due to relatively few symbols required for transmission of the pictorial data (col. 2 lines 1-14).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jwalant Amin whose telephone number is 571-272-2455. The examiner can normally be reached on 9:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Zimmerman can be reached on 571-272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.A. 12/21/06



KEE M. TUNG
SUPERVISORY PATENT EXAMINER